

### **REMARKS**

This is in response to the non-final Office Action mailed on December 15, 2007. No request for an extension is needed.

#### **Priority Acknowledgement**

It is appreciated that the Action acknowledges the filing of the priority documents in the National Stage application from the International Bureau. Thus, all is appropriate in perfecting the priority claim.

#### **Specification**

It is assumed that the amended specification covered by the submission of July 7, 2008 is also appropriate, notwithstanding an absence of a specific statement in the Action to that effect.

#### **Information Disclosure Statements**

It is also appreciated that each of the three IDS documents filed in this application has been acknowledged as considered, according to the attachments to the Action. The comments of the Examiner in the first full paragraph on page 4 of the Action are noted with appreciation, especially for its citation and consideration of the corresponding English language documents for the JP publications cited. It is peripherally noted that the two JP publications relied upon were cited in Category Y in the Supplementary European Search Report and that their relevance to the pending claims is somewhat different than the position found by the Examiner. The thoroughness of the examination is appreciated.

#### **Finding of Allowable Claims**

The Action has noted a finding that claims 6 to 8 and 13 to 16 are allowable if rewritten into allowable form. The Applicant reserves the right to amend the allowable claims to incorporate

respectively the subject matter of unamended claims 1, 2, 9, 10 and 11 pending disposition of this responsive argument.

Rejection of Claims 1 to 4 and 9 to 12 under 35 USC 103(a)

Independent Claims 1 and 9 are amended to recite a feature relating to an aspheric surface in the positive sub lens groups disposed in the fifth lens group. This feature is specifically disclosed' among other places, in the first full paragraph on page 21 of the original specification and in the paragraph spanning pages 21 and 22 of the specification.

As there stated, the merits of the amended claims 1 and 9 thus relate to an improvement of the optical performance by use of an aspherical lens. Essentially, the central area optical performance of the claimed inventive zoom lens is further improved by using the recited aspheric surface in the fifth lens group.

None of the embodiments of JP 07 261,080 disclose the way of reducing performance degradation which occurs when a lens or lens group moves perpendicularly to the optical axis.

Moreover, the rejection is respectfully traversed for additional reasons. Specifically, no embodiment of the '080 publication in fact satisfies the conditional formula recited in claims 1 and 9. While it seems that embodiment 2 of the '080 publication satisfies formula (1), the data for embodiment 2 are inappropriate to enable one of skill to make the lens as disclosed. Specifically  $fw = 3.31$  and  $ft = 36.94$  as stated differ from a recreated lens by a Sony inventor, as we are informed, where  $fw = 4.132$  and  $ft = 45.706$ . Thus, the lens data disclosure of the document relied upon is not proper to constitute an enabling reference negating the patentability of the Applicant's claims.

The Examiner had relied on the Ishii publication for allegedly providing a lens or lens group moving perpendicularly to the optical axis to correct for image shake or blurring. However, there is

not motivation on this record for incorporating the teachings of Ishii to a fifth lens group with a negative lens group and a positive lens group, c.f. the Reasons for Allowance of the examiner, where the positive sub lens group includes an aspheric lens as stated in amended claims 1 and 9.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-3439 from which the undersigned is authorized to draw.

Dated: March 16, 2009

Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

Christopher M. Tobin

Registration No.: 40,290

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

Attorneys for Applicant